

## **REMARKS**

The Applicant has received and reviewed the Office Action dated November 16, 2005 wherein the Office rejected Applicant's claims 18-19 and 21 under 35 U.S.C. 112, second paragraph, as being indefinite and further rejected Applicant's claims 18-19 and 21 under 35 U.S.C. 102(b) as being anticipated by the reference of Riead (U.S. Patent No. 4,461,114).

The applicant's attorney was advised by the applicant, that the applicant, without the approval of applicant's attorney, placed a telephone call to examiner and it is applicant's attorney's understanding that such discussion did not result in any agreement.

### **Prosecution History**

The present application, comprising claims 1-20, was originally filed on January 19, 2001.

On April 18, 2002, the Office issued a restriction requirement to the Application. In response to the Office's restriction requirement of April 18, 2002, the Applicant elected claims 18-20 for prosecution.

On May 29, 2002, the Applicant received a non-final Office Action in which the Office rejected claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram, rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable over Ingram, and rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over the combination of the reference of Ingram and the reference of Behensky. The Applicant, on August 28, 2002, submitted arguments to the Office Action of May 29, 2002. It is noted that only dependent

claim 19 was amended to correct a misspelling. Original independent claim 18 was unchanged.

On November 12, 2002, in response to the Applicant's argument of August 28, 2002, the Applicant received a Final Office Action in which the Office maintained the Office's rejections of May 29, 2002 and further rejected claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite. The Applicant, on January 28, 2003, submitted arguments to the Office's Final Office Action of November 12, 2002. It is noted that only dependent claim 20 was amended to form in order to provide more clarity to claim 20. Original independent claim 18 was unchanged.

On February 24, 2003, the Applicant received an advisory action informing the Applicant that the rejection of claim 20 under 35 USC 112, second paragraph had been overcome. The Office however maintained the rejection of claims 18-20. In response to the Advisory Action of February 24, 2003, the Applicant on March 5, 2003 filed a request for continued examination along with a one-month time extension.

On May 1, 2003, the Applicant received a Final Office Action in which the Office rejected claim 18 under 35 U.S.C. 102(b) as being anticipated by a new reference of Kotis and rejected claims 19 and 20 under 35 U.S.C. 103(a) as being unpatentable over the reference of Kotis. Although the original independent claim 18 was unchanged the rejection on

Ingram was withdrawn. . It is noted that during a telephone conference with the Office regarding the finality of the office action of May 1, 2003, the Office instructed the Applicant to treat the Office Action as a non-final Office Action. The Applicant, on June 13, 2003 submitted arguments to the Office Action of May 1, 2003. It is noted that no claims were amended in the Applicant's arguments of June 13, 2003.

On September 9, 2003, the Applicant received a Final Office Action in which the Office maintained the Office's rejections of May 1, 2003. The Applicant, on February 6, 2004 submitted arguments to the Office Action of September 9, 2003. It is noted that no claims were amended in the Applicant's arguments of February 6, 2004.

On May 19, 2004, the Applicant received a non-final Office Action in which the Office rejected claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Kotis (U.S. Patent No. 3,196,575) and as being anticipated by the reference of Ingram (U.S. Patent No. 2,500,078); rejected claims 19-20 under 35 U.S.C. 103(a) as being unpatentable over the reference of Kotis; further rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable over the reference of Ingram; and further rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over the combination of the reference of Ingram and the reference of Behensky.

In response to the Office Action of May 19, 2004, the Applicant filed a Notice of Appeal on August 19, 2004. In further response to the Office Action of May 19, 2004 and in order

to try and conclude the case without having to go forward with the Appeal, the Applicant's Attorney, Thomas Phung (Reg. No. 53,466) placed a telephone call to the Office on September 9, 2004 to discuss the Office rejection of May 19, 2004 and to further present the Applicant's position. During the teleconference, the Applicant's Attorney respectfully directed the Office's attention to certain elements of Applicant's independent claim 18 that were not found in the cited prior art. After the Applicant's Attorney presented the Applicant's case to the Office, the Office instructed the Applicant's Attorney to file a Request for Reconsideration laying out the points that were presented in the teleconference (of September 9, 2004), for further consideration. The Applicant on September 14, 2004 filed a request for reconsideration with further arguments pursuant to the aforementioned teleconference of September 9, 2004. It is noted that no claims were amended in the Applicant's request for reconsideration of September 14, 2004.

In regards to the request for reconsideration of September 14, 2004, it is noted that the Applicant's Attorney, Thomas Phung, made telephone inquiries with the Office on October 12, 2004, October 15, 2004, October 18, 2004 inquiring on the status of the Applicant's request for reconsideration of September 14, 2004.

On October 18, 2004, the Office notified that Applicant's attorney that the Office has decided to maintain the Office's rejection of May 19, 2004. October 20, 2004, the Applicant received an advisory action in which the Office indicated that the Applicant's request for reconsideration dated September 14, 2004 did not place the application in a condition for allowance. The Applicant, on November 11, 2004 submitted arguments to the

Office's advisory action of October 20, 2004. It is noted that no claims were amended in the Applicant's arguments of November 11, 2004.

On January 13, 2005, the Applicant received a Final Office Action wherein the Office now rejected claim 18 under Ingram as opposed to the previous rejection on Kotis, the office rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable over the reference of Ingram; and rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over the combination of the reference of Ingram and the reference of Behensky. . The Applicant, on February 14, 2005 submitted arguments to the Office's Final Office Action of January 13, 2005. The Applicant notes that no previously pending claims were amended in the Applicant's arguments of February 14, 2005.

March 3, 2005, the Applicant received an advisory action informing the Applicant that the Applicant's response of February 14, 2005 will not be entered by the Office because it raises new issues that would require further consideration and/or search, namely "... the limitation that the displacement is over an entire range of motion of the members so as to provide a gradual resistance is new issue which require further consideration." In response to the Advisory Action of March 3, 2005, the Applicant on March 14, 2003 filed a request for continued examination to enter the Applicant's response of February 14, 2005.

On June 6, 2005, the Applicant received a non- Office Action wherein the Office rejected Applicant's independent claims 18 and 21 under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram (U.S. Patent No. 2,500,078). The Office also rejected Applicant's

dependent claim 19 under 35 U.S.C. 103(a) as being unpatentable over the reference of Ingram.

The Office, however, indicated that Applicant's dependent claim 20 contains allowable subjected matter. More specifically, the Office on page 3, lines 19-21 of the Office Action held that dependent claim 20 "...would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." In view of the Office's aforementioned statement and in order to place the Application in a condition for allowance, the Applicant on August 25, 2005, responded to the Office Action of June 6, 2005 by canceling dependent claim 20 and adding the subject matter of dependent claim 20, which the Office indicated as being allowable subject matter, to both independent claim 18 and independent claim 21. The Applicant respectfully submits that the Applicant would not have made amends to claims 18 and 21 and canceled claim 20 but for the Office's statement on the allowability of claim 20 in the Office Action of June 6, 2005.

On November 16, 2005, in response to the Applicant's amendment of August 25, 2005, the Applicant received a Final Office Action wherein the Office rejected Applicant's claims 18-19 and 21 under 35 U.S.C. 112, second paragraph, as being indefinite and further rejected Applicant's claims 18-19 and 21 under 35 U.S.C. 102(b) as being anticipated by the reference of Riead (U.S. Patent No. 4,461,114).

### **Addition of Original Claim**

Please note that original claim 18 has been added and labeled as new claim 22 in order to comply with rules regarding amended claims. The Applicant respectfully submits that the office enter new claim 22, which is identical to original independent original claim 18 since it raises no new issues. The applicant acknowledges that at various times the office rejected original claim 18 (now claim 22) under Kotis in one action and under Ingram in another action and now rejects the claims on file under Riead. Applicant hereby responds to the new rejection of Riead and intends to appeal on the rejections of original claim 18 (now claim 22) on Kotis and Ingram since both have been the subject of previous rejections.

### **Rejection under 35 U.S.C. 112, Second Paragraph**

Claims 18-19 and 21 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite due to insufficient antecedent basis in the claim. In response to the Office's aforementioned rejections the Applicant has amended claims 18 and 21 to provide for proper antecedent basis. In view of the aforementioned, the Applicant respectfully request that the Office's rejection of claims 6 and 7 under 35 U.S.C. 112, second paragraph, be withdrawn.

### **Rejection under 35 U.S.C. 102(b) to Riead.**

Applicant's claims 18-19 and 21 stand rejected under 35 U.S.C. 102(b) as being anticipated by the reference of Riead (U.S. Patent No. 4,461,114).

In regards to Applicant's amended independent claims 18 and 21, Applicant's amended independent claim 18 calls for a two-stage fishing bobber responsive to different fishing forces, the fishing bobber including:

“... a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and a resiliently displaceable member to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.” (Emphasis added.)

Applicant's amended independent claim 21 calls for a two-stage fishing bobber responsive to different fishing forces, the fishing bobber including:

“...a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and a resiliently displaceable member to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body over an entire range of motion of the member so as to provide gradual resistance.” (Emphasis added.)

In support of the Office's rejection of Applicant's independent claims 18-19 and 21, the Office on page 2, lines 20-25 and page 3, lines 1-4 stated:

“The patent to Riead shows a bobber in Fig. 1 having a main body 2 providing a buoyant force to normally maintain the bobber main body in a floating condition and a spring 64 having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member 62 to allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance as disclosed in column 5, lines 1-25.”



The Applicant respectfully but strenuously disagrees with the Office's above statement. More specifically, the Applicant respectfully submits that the reference of Riead does not show Riead's spring 64 as having a spring constant to compress the spring 64 with respect to the bobber main body 2 being approximately equal to the total force to submerge the bobber main body 2 and Riead's washer 62 "...to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance" or "to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body over an entire range of motion of the member so as to provide gradual resistance" as called for in Applicant's amended independent claims 18 and 21.

Instead, attention is directed to column 5, lines 1-25 wherein Riead specifically teaches his spring 64 as having a tension that provides sufficiently sensitivity to his lamp switch 40 so that:

"...the lamp will be lighted by an additional leader load less than that required to submerge the float completely." (Emphasis added.)

It is respectfully submitted that by teaching that the compression of Riead's spring 64, which leads to the lighting of Riead's lamp, by an additional leader load less than that required to submerge the float completely, that the reference of Riead further does not teach the subject matter of Applicant's independent claims 18 or 21 as the reference of Riead does not provide for the "... simultaneous submersion of the bobber main body and

the displacement of the member with respect to the bobber main body so as to provide gradual resistance” or “...to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body over an entire range of motion of the member so as to provide gradual resistance.”

It is for the above reasons that the Applicant respectfully submits that Applicant’s independent claims 18 and 21, as amended, are allowable over the reference of Riead.

In regards to Applicant’s dependent claim 19, Applicant’s dependent claim 19 calls for the fishing bobber of claim 18:

“...wherein the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body so that the when the member is in the down position the bobber main body is submerged.” (Emphasis added.)

The Applicant respectfully submits that the reference of Riead does not teach the force to displace Riead’s washer 62, which the Office asserts is equivalent to the displacement member of Applicant’s claim 9, as being substantially equal to the buoyant force of Riead’s body 2 so that when Riead’s washer 62 is in the down position Riead’s body 2 is submerged. Instead, it is submitted that Riead specifically teaches the opposite in column 5, lines 1-25, namely that Riead’s washer 62 is first displaced (without the submergence of Riead’s body 2) to light Riead’s lamp in order to provide a visual signal to the fisherperson that a fish has taken the bait. It is only after then that Riead’s body 2 submerges. Further support for the aforementioned can be specifically found in column 5, lines 10-12 wherein

Riead teaches that his device would be worthless if the washer 62 is displaced and the lamp is lighted after the float was submerge.

In further regards to Applicant's dependent claim 19, Applicant's dependent claim 19 depends on independent claim 18. Since independent claim 18, as currently amended, is allowable for the reasons given above, Applicant respectfully submits that dependent claim 19 is also allowable.

In view of the above, it is respectfully submitted that the application is in condition for allowance. Allowance of claims 18, 19, and 21, as amended, is respectfully requested. Applicant has enclosed a marked-up version of the amendment showing changes made with this response.

Respectfully submitted,

**JACOBSON AND JOHNSON**

By



Carl L. Johnson, Reg. No. 24,273  
Attorneys for Applicant  
Suite 285  
One West Water Street  
St. Paul, Minnesota 55107-2080  
Telephone: 651- 222-3775  
Fax: 651-222-3776

CLJ/cj  
Enclosure